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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,625	02/26/2002	Koichi Naoi	1217-012195	1574

7590

06/24/2003

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT

PAPER NUMBER

1775

4

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/069,625

Applicant(s)
NAOI ET AL.

Examiner
LA VILLA

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1775



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Feb 26, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.
2. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
3. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.
4. The abstract contains more than the permitted 150 words. Appropriate correction is required.

Claim Objections

5. Claims 3, 16, 32, 35, and 42-45 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
 - I. Regarding Claims 3, 16, and 35, if the stainless steel layer is not required to be white colored, the claims are not further limiting.
 - II. Regarding Claims 32 and 45, the claimed additional steps are described as being formed on an underlayer or ornament surface not

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described in the relevant independent claims. Hence, these claims are not properly further limiting.

- III. Regarding Claims 42-44, if the claimed underlayer to be formed by these claims supersedes the structure of Claim 24, these claims are not properly further limiting.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:
7. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- I. Regarding Claims 1-45, it is unclear what is meant by the phrase "white-colored." It is unclear whether this designation is limited by some standard of measurement of color.
- II. Regarding Claims 8 and 25, it is unclear whether Claims 8 and 25 limit the underlying plating layer to the described Ni-P alloy or not.
- III. Regarding Claims 3 and 35, it is unclear whether Claims 3 and 35 require a white-colored stainless steel coating layer.
- IV. Regarding Claim 12, it is unclear what is the antecedent basis of the phrase "white surface coating layer" as the preamble of Claim 1 makes no mention of a "surface" coating layer.

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- V. Regarding Claim 16, it is unclear what is the antecedent basis of the phrase "or of the underlying plating layer." Claim 1 makes no mention of such an underlying layer. It is unclear what is meant by the phrase "in addition to the stainless steel coating layer." It is unclear whether this stainless steel layer is required to be white-colored. It is unclear what is the claimed order of deposition of the layers. Is the "at least one plating layer different in color tone" necessarily to be formed on top of the stainless steel coating layer?
- VI. Regarding Claims 32, it is unclear what is the antecedent basis of the phrase "or of the underlying plating layer." Claim 19 makes no mention of such an underlying layer.
- VII. Regarding Claim 45, it is unclear what is the antecedent basis of the phrase "on the surface of the ornament base article." Claim 20 requires that the stainless steel coating layer be formed on the underlying coating layer.
- VIII. Regarding Claims 32 and 45, it is unclear what is meant by the phrase "after the steps of forming" as Claims 19 and 20 form a white-colored stainless steel coating layer in one step. Are there other contemplated steps or is reference being made to the preparatory steps taken before the recited stainless steel coating step of Claims 19 and 20?
- IX. Regarding Claims 42-44, it is unclear whether the claimed underlayer plating layer that is to be formed of the claimed materials and by the

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claimed process is supposed to replace the entire previously described underlayer plating layer or whether these claims further limit the already described underlayer structure of Claim 24.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1, 3, 5, 12, and 14-18 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Tyler et al. USP 3,778,238. Tyler teaches laminate materials having a stainless steel SUS304 outer coating layer, in which the laminates are precursor materials for making personal ornament articles. See Tyler (Abstract; Figures; col. 1, lines 3-47; col. 3, lines 27-62; col. 4, line 57 through col. 5, line 5; col. 5, line 45 through col. 6, line 20). Tyler does not exemplify a personal ornament article, but does teach that the articles of Tyler are useful for making

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such articles. It would have been obvious to one of ordinary skill in the art at the time of the invention to fabricate personal ornament articles from the laminate precursor materials of Tyler as Tyler teaches that the laminate precursor materials are useful for that purpose. Applicant at page 26, line 7 teaches that SUS 304 is a white-colored stainless steel. Tyler suggests that gold layers may be applied over the coating layer. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a gold layer over the stainless steel coating layer as Tyler teaches that favorable decorative effects are achieved in this manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thicknesses in the range of thicknesses disclosed by Tyler as Tyler teaches that stainless steel and gold layers of these thicknesses are effective.

Allowable Subject Matter

12. Claims 4, 6-11, 13, and 21-45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
13. Claims 2, 19, and 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.
14. None of the reviewed prior art nor the prior art of record appears to teach or render obvious the subject matter of Claims 2, 4, 6-11, 13, and 19-45. Groll USP 6,267,830, Spring USP 5,952,112, and Ulam USP 4,646,935, none of which has

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been applied in rejecting claims, teach and suggest applying stainless steel coating layers on metal articles. However, these metal articles are described as cooking utensils. Cooking utensils do not appear to be encompassed by applicant's claimed "personal ornament" as described in the Specification at page 14, lines 6-10. Moreover, although Ohta USP 4,666,743 teaches decorative sheets having stainless steel coatings, these decorative sheets are not personal ornament articles either. Hence, in view of the reviewed prior art and the prior art of record, Claims 2, 4, 6-11, 13, and 19-45 would be allowable upon overcoming the outstanding section 112, second paragraph rejections.

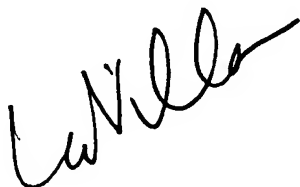
CONCLUSION

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (703) 308-4428. The examiner can normally be reached on Monday through Friday.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Michael La Villa
June 14, 2003

A handwritten signature in black ink, appearing to read 'La Villa', written in a cursive style.